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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
BLACKWELL, JAMES H	

ART UNIT	PAPER NUMBER
2176	

DATE MAILED: 03/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/673,674	HITCHCOCK ET AL.	
	Examiner	Art Unit	
	James H. Blackwell	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 March 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *56-119* is/are pending in the application.

4a) Of the above claim(s) *1-55* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *56-119* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *29 September 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *9/29/03, 3/24/04*. 8/4/04, 2/11/05, 10/17/05
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is in response to an original application filed 09/29/2003 with a priority date of **06/04/1998**.

2. Claims 1-55 have been cancelled by the Applicant by pre-amendment.

3. Claims 56-119 are currently pending and are new claims.

4. Claims 56, 80, 81, 84, 104, 105, 109 and 116 are independent claims.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 73-74, 100, 102, and 112 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, in these claims, the term "posted" is unclear as to whether it relates to validation upon input of information (client-side, before submitted to server), or validation after the form has been submitted to the server (server-side).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 56-75, 79, 81, and 84-116 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartman et al. (hereinafter Hartman, U.S. Patent No. 5,758,324 filed 02/08/1996, issued 05/26/1998), in view of Tobin (U.S. Patent No. 6,141,666 filed 01/21/1997, issued 10/31/2000), and in further view of Daniels et al. (hereinafter Daniels, U.S. Patent No. 5,758,126 filed 03/19/1996, issued 05/26/1998).

In regard to independent Claim 56 (and similarly independent Claims 80, 84, and 104-106, 109, 116), Hartman teaches a resume storage and retrieval system whereby potential applicants can post resumes and potential employers can search and receive resumes from those applicants.

A job applicant requests to enter new applicant data (Fig. 8B, S3), the server assigns a user ID and requests a password from the applicant (Fig. 9, S12), a resume outline form is sent (S15). The applicant fills out the outline form describing the content of their resume. This information is then stored on the server in a database (Fig. 9, S19), the applicant is then sent a list of methods for receiving an image of their resume (S20), which is then uploaded to the server where it is also saved in a database (Fig. 9, S24). Thus, Hartman teaches *a method of processing network forms, which can be*

submitted by multiple job seekers to a server, which, in turn, can be accessed by multiple employers (see Fig. 1). Though not explicitly stated by Hartman, it would have been obvious to one of ordinary skill in the art at the time of invention to have assumed that the server described by Hartman was owned and maintained by a third party or "clearing house" that provided standardized access to resumes for both potential employees and employers to locate one another.

Hartman fails to teach that the eventual recipients of the resumes (employers) are *institutes of higher learning*, as claimed. However, it would have been obvious to one of ordinary skill in the art at the time of invention that the concept of using a clearing house type, third party model for resume access as taught by Hartman would have been applicable for also handling college applications as claimed, providing a benefit of standardization and uniformity of form input.

Hartman teaches that a server (12) (third party) communicates to the applicant's client machine a resume outline form 30 (Fig. 3) to be completed by a job applicant. The form (30) has a plurality of fields (31) relevant to employment, using which typical information found on a resume is summarized by the applicant, The form (30) has fields that are similar to blanks found on traditional job application forms available from employers (Col. 5, lines 26-33).

Hartman fails to explicitly teach *a form directed to one of the multiple institutions of higher education, the form being generated by a forms generator that generates multiple forms corresponding to multiple institutions of higher education, the forms generator generating forms that are customized in appearance and content in*

accordance with the preference of the institution to which each of the forms is directed and that include an indication of source corresponding to the institution to which each of the forms is directed so as to provide to the users of the forms the appearance that the forms are associated with the specific institutions to which they are directed. However, Tobin teaches presenting HTML documents (to include forms), which contain hypertext links, presented as single links or image maps, i.e., grouped links, which are anchored to data that is dynamically retrieved by the database means in response to the particular class to which the client belongs to, i.e. based on the identify of the network site referring the client to the system's server (Col. 3, lines 23-29). In other words, Tobin teaches that a user accesses an initial web site (e.g., a specific school), and selects a link (e.g., an admissions form). The link is to another server that based on the origin of the link (e.g., its URL), provides differing information and/or "look and feel" based on where the link came from. The content (page, forms, image maps) that is returned are "branded" according to a class. It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Hartman and Tobin as both inventions relate to interactive forms. Adding the teaching of Tobin provides the benefit of branding a web page to a particular entity

Neither Hartman nor Tobin teaches a forms generator. However, Daniels does generate forms based on initial inputs provided by a user (Col. 9, lines 3-20). t would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Hartman, Tobin, and Daniels as all three inventions relate to interactive

forms. Adding the teaching of Daniels provides the benefit of dynamically generating forms based on inputs from a user.

Hartman continues by teaching that the *forms including fields for the forms users to enter user information* and *entering user information onto the form* (Col. 5, lines 26-33).

Hartman also teaches *entering payment information* in that from an employer's perspective, filling a search form, from the third-party server, with user information and, once results are received, requests can be made for resumes but only after a fee is paid. The employer may establish an account, and provide billing information (such as by providing a credit card number) to the administrator of the system 10 at one time, and will then be able to subsequently log in using a password, and order contact information and graphics files without having to again transmit a credit card. In this manner, the employer can connect once using a telephone connection or secure connection, transmit the billing information, and subsequently use an insecure connection (Col. 9, lines 1-9). Thus, from this teaching, the limitation of *receiving by the third party forms servicer over the computer network user information and electronic payment information entered by the user* would have been obvious to one of ordinary skill in the art at the time of invention because, at least from the perspective of an employer using the service to access resumes of potential employees, information is entered and fees are collected for services rendered, providing the benefit of linking job seeker and employer through a third party.

Hartman also teaches *storing by the third party forms servicer at least some of the user information entered on the form in a user database* (Col. 6, lines 48-50).

Hartman also teaches *making web-based viewing or uploading of at least some of the stored user information in the user database available by the third party forms servicer to the one of the multiple institutions to which the form is directed* in that employers seeking potential employees can access the third party server hosting resumes and other searchable information from potential employees via a form which then takes that input and searches the resume database based on the employers inputs and presents the employer with limited results (see above rejection).

Hartman also teaches access via the web (Col. 3, lines 52-57).

In regard to dependent Claim 57 (and similarly dependent Claims 85, and 106), Claim 57 (and similarly Claims 85, and 106) contains subject matter similar to that contained in Claim 56 (and similarly claims 80, 84, 104-106, 109, and 116) and is rejected along similar lines. In addition, it is noted that the third party server taught by Hartman previously was intended to serve multiple employers and multiple employees (see Fig. 1 for example).

In regard to dependent Claim 58 (and similarly dependent Claims 86, and 107, Hartman fails to teach *providing the ability to sort data*. However, sorting search results was well known in the art at the time of invention providing the benefit of quickly locating items of interest based on a sorting key.

In regard to dependent Claim 59 (and similarly dependent Claims 87, and 108), Hartman teaches *making user information available from all or a subset of the*

forms directed to that institution in that resumes are available to employers for a fee (see rejection of Claim 56 (and similarly claims 80, 84, 104-106, 109, and 116)).

In regard to dependent Claims 60-65 (and similarly dependent Claims 88-92), Hartman fails to teach *data analysis of stored information*. However, Hartman does make such raw information available for a fee. In addition, once an employer has such data in hand, it would have been obvious to perform data organization and analysis such as is claimed in Claim 60-64 (and 88-91) providing the benefit of quickly determining the right candidates from a field of resumes.

In regard to dependent Claim 66 (and similarly dependent Claim 93), Hartman teaches *entering payment information includes entering payment information onto the form* (see Fig. 12a, Steps S46-48).

In regard to dependent Claim 67 (and similarly dependent claims 94, both Hartman and Tobin fail to teach *presenting ... a second form directed to one of the multiple institutions of higher education; and automatically inserting from the user database into the second form user information previously entered onto a form directed to one of the multiple institutions by the form user.* However, Daniels teaches the notion of *turn-around*, which allows a user client (30) to generate a turn-around document in response to a document received from sponsor client 20 (e.g., *requesting a second document*). Turn-around functionality is accessed from a "doc turn" button on the tool bar of the main menu. When the doc turn button is actuated, a dialog is opened which allows an operator of user client 30 to select which document is being responded to by document number and which turn-around document is being generated. When the turn-

around document has been selected, the information fields of the GUI representing the turn-around document are *populated with information from the original electronic form* (Col. 13, lines 9-51). Thus, Daniels pre-populates information from the first form into the second requested form. It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Hartman, Tobin and Daniels as all three inventions relate to forms processing. Adding the teaching of Daniels provides the benefit of recall of previous inputs to forms.

In regard to dependent Claim 68 (and similarly dependent Claim 95), both Hartman and Tobin fail to teach *verifying that the user information satisfies criteria specified by the one of the multiple institutions of higher education to which the form is directed.* However, Daniels teaches that an electronic forms application preferably includes instant editing functionality which verifies information entered in the fields of a form(s) against an acceptable format or a database of acceptable entries and thus provides the user of the electronic forms application with immediate feedback about the acceptability of an entry into one of the fields of the form (Col. 9, lines 21-50). Thus, Daniels teaches validation/verification of form content from a client-side application, providing instant checking before information is sent via modem elsewhere. It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Hartman, Tobin and Daniels as all three inventions relate to forms processing. Adding the teaching of Daniels provides the benefit of forms validation.

In regard to dependent Claim 69 (and similarly dependent Claims 97, Hartman teaches *presenting a form including multiple pages* in that it does allow for the

production of forms which, depending on the amount of content provided by the user might span more than a single page (see Fig. 3 employment history provides for multiple inputs, thus potentially expanding the form to more than a single page).

In regard to dependent Claim 70, 71 (and similarly dependent Claims 98, 96), both Hartman and Tobin fail to teach *verifying that the user information satisfies criteria specified by the one of the multiple institutions of higher education to which the form is directed.* However, Daniels teaches that an electronic forms application preferably includes instant editing functionality which verifies information entered in the fields of a form(s) against an acceptable format or a database of acceptable entries and thus provides the user of the electronic forms application with immediate feedback about the acceptability of an entry into one of the fields of the form (Col. 9, lines 21-50). Thus, Daniels teaches validation/verification of form content from a client-side application, providing instant checking before information is sent via modem elsewhere. It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Hartman, Tobin and Daniels as all three inventions relate to forms processing. Adding the teaching of Daniels provides the benefit of forms validation.

In regard to dependent Claim 72 (and similarly dependent Claims 99, both Hartman and Tobin fail to teach that *the validation criteria are specified by the school to which the form is directed.* However Daniels teaches validation of form input fields based on content and format comparisons to database stored values (see Claims 2, and 23-24). t would have been obvious to one of ordinary skill in the art at the time of

invention to combine the teachings of Hartman, Tobin, and Daniels as both inventions relate to forms processing. Adding the teaching of Daniels provides the benefit of forms validation based on provided rules.

In regard to dependent Claims 73, 74 (and similarly dependent Claims 100, 102), both Hartman and Tobin fail to teach *verifying in accordance with first validation criteria user information on each of the multiple pages as they are posted and verifying in accordance with second validation criteria user information when a completed form is submitted.* However Daniels teaches validation of form input fields based on content and format comparisons to database stored values (see Claims 2, and 23-24). Though it appears from Daniels that both of these verification steps take place either on a client or on a server, it would have been obvious to one of ordinary skill in the art at the time of invention to perform one or both functions either on a client or on a server, or split between the two. The latter would better split the processing chores between two computers thereby saving time and effort. t would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Hartman, Tobin, and Daniels as both inventions relate to forms processing. Adding the teaching of Daniels provides the benefit of forms validation based on provided rules.

In regard to dependent Claim 75, Hartman fails to teach *presenting the form in response to activation by the form user of a hyperlink to the form, the hyper linking to the form occurring from an individual institution's web site without any visible intervening linkage to any page naming another institution.* However, Tobin teaches presenting HTML documents (to include forms) which contain hypertext links, presented as single

links or image maps, i.e., grouped links, which are anchored to data that is dynamically retrieved by the database means in response to the particular class to which the client belongs to, i.e., based on the identity of the network site referring the client to the system's server (Col. 3, lines 23-29).

In other words, Tobin teaches that a user accesses an initial web site (e.g., a specific school), and selects a link (e.g. an admissions form). The link is to another server that based on the origin of the link (e.g. its URL), provides differing information and/or "look and feel" based on where the link came from. The content (page, forms, image maps) that is returned are "branded" according to a class.

Tobin goes on to teach that such a dynamic retrieval of data facilitates dynamic configuration of content on all anchored HTML documents so as to meet specific requirements of a marketing participant. Customization can be either a co-branded format, whereby content includes both the host's brand name and the participant's brand name, or a private label format, whereby only the marketing participant's brand name is displayed on the HTML documents presented to clients (Col. 3, lines 30-37). It is the "private label format" of branding that relates to the claimed limitation above.

It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Hartman, and Tobin as both inventions relate to forms processing. Adding the teaching of Tobin provides the benefit of branding a web form.

In regard to dependent Claim 79 (and similarly dependent Claims 103, and 115), Hartman teaches a computer readable media comprising computer instruction for performing the steps of claim 56 (See Fig. 2).

In regard to independent Claim 81 (and similarly independent Claim 116), Claim 81 (and similarly Claim 116) reflects the method as claimed in Claims 56, and 76 and is rejected along the same rationale.

In regard to dependent Claim 101, Claim 101 reflects the method of Claims 70-74 and is rejected along the same rationale.

In regard to dependent Claim 110, Claim 110 reflects the method of Claim 56 and is rejected along the same rationale.

In regard to dependent Claim 111, Claim 111 reflects the method as claimed in Claim 56 (and similarly independent Claims 80, 84, and 104-106, 109, 116), and is rejected along the same rationale. In addition, it would have been obvious to one of ordinary skill in the art at the time of invention to have allowed a third party to charge a users fee, providing a source of revenue for the third party for hosting resumes.

In regard to dependent Claim 112, Claim 112 reflects the method as claimed in Claim 56 (and similarly independent Claims 80, 84, and 104-106, 109, 116), and is rejected along the same rationale. In addition, Hartman fails to teach *web-based viewing or uploading of user information by an institution includes web-based viewing or uploading of user information derived from a form customized for and primarily identified with the first institution, the user information including information that was: posted by the form user on a previously completed form customized for and identified primarily*

with a second institution, stored by the third party forms servicer, and automatically inserted into the form customized for and identified with the first institution, thereby allowing the form user to enter information on a form associated with one institution, the information being saved and automatically inserted into a subsequent form associated with a different institution.

However, Daniels teaches the notion of *turn-around*, which allows a user client (30) to generate a turn-around document in response to a document received from sponsor client 20 (e.g., *requesting a second document*). Turn-around functionality is accessed from a "doc turn" button on the tool bar of the main menu. When the doc turn button is actuated, a dialog is opened which allows an operator of user client 30 to select which document is being responded to by document number and which turn-around document is being generated. When the turn-around document has been selected, the information fields of the GUI representing the turn-around document are *populated with information from the original electronic form* (Col. 13, lines 9-51). Thus, Daniels pre-populates information from the first form into the second requested form. It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Hartman, Tobin and Daniels as all three inventions relate to forms processing. Adding the teaching of Daniels provides the benefit of recall of previous inputs to forms.

In regard to dependent Claim 113, Claim 113 reflects the method as claimed in Claims 68, 70-74, 95-96, 98-99, 100, and 102, and is rejected along the same rationale.

In regard to dependent Claim 114, Claim 114 reflects the method as claimed in Claims 69, and 97, and is rejected along the same rationale.

9. Claims 76-78, 82-83, and 117-119 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartman in view of Tobin, and in further view of Daniels, and in further view of Wong et al. (hereinafter Wong, U.S. Patent No. 5,890,175 filed 09/25/1996, issued 03/30/1999).

In regard to dependent Claim 76, none of Hartman, Tobin, or Daniels teaches *altering the form data over the world wide web by the one of the multiple institutions to which the form is directed, and presenting to a second form user over a computer network by the third party forms servicer in response to a request from the second form user, a second form directed to that institution, the second form being generated by the forms generator from the altered form data, the second form customized in appearance and content in accordance with the preference of that institution so as to provide to the second form user the appearance that the second form is associated with that institution*. However, Wong teaches the dynamic generation of catalogs of products based on raw data and a number of form "templates" that can be edited by an individual merchant to present individual products and associated required and optional information needed to further inquire and/or purchase the given product. Wong's invention would allow a given merchant to for example, change pricing for a product and given that the catalogs are dynamically generated, have the next potential customer view the newly updated price (Abstract). It would have been obvious to one of ordinary

skill in the art at the time of invention to combine the teachings of Hartman, Tobin, Daniels and Wong as all inventions relate to forms processing. Adding the teaching of Wong allows the merchant to easily change information in their catalog based on new or updated information.

In regard to dependent Claim 77 (and similarly dependent Claim 118), none of Hartman, Tobin, or Daniels teaches *altering the form data without manual intervention by the third party forms servicer.* However, Wong teaches such a limitation as it assumes that a given merchant is part of a larger online venture Mallenium (see Figs. 3-11) that would correspond to the third party. As taught by Wong in Claim 76, the individual merchant is allowed to change their information online. t would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Hartman, Tobin, Daniels and Wong as all inventions relate to forms processing. Adding the teaching of Wong allows the merchant to easily change information in their catalog based on new or updated information autonomously.

In regard to dependent Claim 78 (and similarly dependent Claims 83, and 117), none of Hartman, Tobin, or Daniels teaches *altering the form data includes altering deadline dates related to submission of the form.* However, Wong teaches such a limitation (see Fig. 8 altering of dates possible from form template). It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Hartman, Tobin, Daniels and Wong as all inventions relate to forms processing. Adding the teaching of Wong allows the merchant to easily change information in their catalog based on new or updated information autonomously.

In regard to dependent Claim 82 (and similarly dependent Claim 119), none of Hartman, Tobin, or Daniels teaches *presenting a form generated from form data includes presenting a form generated from an XML file that describes form.* However, Wong teaches generating forms based on HTML, which describes the form. HTML is a form of markup as is XML. Thus, it would have been obvious to one of ordinary skill in the art at the time of invention to use a markup language to describe forms, providing the benefit of using a common language to describe forms for use in online forms. I t would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Hartman, Tobin, Daniels and Wong as all inventions relate to forms processing. Adding the teaching of Wong allows the merchant to use a standard markup language in defining information for use in creating forms.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Blackwell whose telephone number is 571-272-4089. The examiner can normally be reached on Mon-Fri.

11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R. Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James H. Blackwell
03/15/2006

William L. Bashore
WILLIAM BASHORE
PRIMARY EXAMINER
3/15/2006